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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,004	03/05/2002	Robert J. Yamartino	025965.101-US03	5161

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WASHINGTON, DC 20004-2401

EXAMINER

SMITH, CREIGHTON H

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090004

Applicant(s)

TAMARINO

Examiner

SMITH, C.H.

Group Art Unit

2645

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

3

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9 July '04
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-72 is/are pending in the application.
- Of the above claim(s) 1-11, 21, 22, 37-46, 57, 58 is/are withdrawn from consideration.
- ☒ Claim(s) 12-20, 23-36 is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 47-50, 59-61, 65-68, 72 are rejected under 35 U.S.C. 102(e) as being anticipated by Yablon.

Examiner disagrees with Applicant's 1st argument that Yablon does not disclose any "called party information." The called party information is disclosed in col. 6, lines 5-10, when the calling party dials 4-1-1 and requests "telephone numbers to be conveyed to him." These telephone numbers that are to be conveyed to him are the "called party information." Examiner disagrees with Applicant's 2nd argument on page 3 that Yablon does not disclose producing telephone numbers *in response to* called party information. The 4-1-1 operator produces the list of telephone numbers that the calling party has requested and sends it to the calling party "electronically via DTMF emitter", line 8 of col. 6.

Yablon discloses in col. 6, line 5, that a user will dial a directory assistance (DA) and ask for a telephone number to be conveyed to him electronically, and in col. 8, lines 15-20, Yablon discloses "downloading one or more telephone numbers from a remote location into the primary user's telephone." The plurality of downloaded phone numbers are shown in Fig. 1 (left side of drawings), fig. 5, Fig. 6. The step of monitoring for call initiation signals from the calling party is met by Yablon when he goes "off-hook" or switches on his cell phone alerting the MSC that he, the user, is now ready to transmit

and receive phone calls. Applicant's step of receiving called party information is met by Yablon when he calls DA for his messages; the producing a list of phone numbers step is met by Yablon when the directory assistance downloads the user's messages into the user's phone's memory, and then the user will select a specific phone number from the plurality of phone numbers downloaded from the DA to call back. Applicant's step of associating identification information with the calling party is met in col. 16, lines 50-55, where it is disclosed that a user has an associated password code. Also, in col. 24, lines 50-55, Yablon discloses that the Caller ID is used to disclose the calling party to the called party. Similarly, Caller ID could be used by the DA as the identification information with the calling party.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11, 51, 62-64, 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablon in view of Walsh et al

Walsh discloses the use of dialing rules, col. 9, lines 50-55, col. 4, lines 5-18, when utilized with lists of telephone numbers, claim 19. To have similarly used Walsh's teaching of using dialing rules in Yablon apparatus would have been obvious to a person having ordinary skill in the art.

Claims 12-20, 23-36, 52-56 are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Creighton h Smith at telephone number 308-2488.

14 September '04

A handwritten signature in black ink, appearing to read "Creighton h Smith", with a stylized flourish at the end.

Creighton h Smith
Primary Examiner
Art Unit 2645